UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,081	08/24/2001	Zoran Cetusic	7320-146	5746

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EXAMINER
GARY, ERIKA A

ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)	
Office Action Summary	09/939,081	CETUSIC ET AL.	
	Examiner	Art Unit	
	Erika A. Gary	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*10 July 2006*</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

    4a) Of the above claim(s) *14-35,38 and 39* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13,36 and 37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *14-35,38 and 39* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.   Claims 1-13, 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated

by applicant's submission of prior art, Schumacher et al., US Patent Number 5,841,854

(hereinafter Schumacher).

Regarding claim 1, Schumacher discloses a system comprising: a private

communication server maintaining availability information regarding a plurality of users;

a plurality of personal communication subsystems, each associated with a user in the

plurality of users and each in wireless communication with said server; and a data

channel between said server and a first one of said plurality of subsystems, the first one

of said subsystems being associated with a first user; wherein said server is configured

to communicate at least a portion of the availability information through said data

channel to at least a first subsystem, and to respond to command signals carried from

the first subsystem to said server by said data channel [fig. 1; col. 5: line 25 – col. 6: line

8; col. 7: lines 15-18; col. 9: lines 38-44; col. 10: lines 39-44, 55-59].

Regarding claim 2, it is inherent to update the availability information at

predetermined intervals in order to detect a change in availability.

Regarding claim 3, Schumacher discloses said command signals comprise a request for an update to the at least a portion of the availability information when the availability information changes for a second user in the plurality of users, and said server is further configured to provide the requested update in response to said request [col. 8: lines 8-14].

Regarding claim 4, Schumacher discloses said server provides the update through said data channel [col. 13: lines 25-28].

Regarding claim 5, Schumacher discloses the request specifies a particular new status, and the change is an update of the second user to the particular new status [col. 8: lines 8-14].

Regarding claim 6, Schumacher discloses said server provides the updates by establishing a voice connection between the first user and the second user through the voice channel when the availability information changes for a second user to a predetermined state [col. 11: lines 55-61].

Regarding claim 7, Schumacher discloses said first subsystem has a user interface; and said request is generated by said first system in response to a single action in the user interface by the first user [fig. 1].

Regarding clam 8, it is inherent that the association between the first subsystem and the first user is made using a log-in procedure.

Regarding claim 9, Schumacher discloses the portion of the availability information accessible to the first subsystem is limited on the basis of the association with the first user [col. 6: lines 33-56].

Regarding claim 10, Schumacher discloses the first user is associated with one

or more organizations, and the limiting allows access by the first user to availability

information relating only to users who are also associated with at least one of the one or

more organizations [col. 6: lines 33-56].

Regarding claim 11, Schumacher discloses the first subsystem comprises a

personal digital assistant, and it is inherent that the log-in procedure is performed using

the personal digital assistant [col. 10: lines 47-54].

Regarding claim 12, Schumacher discloses each subsystem in said plurality of

subsystems comprises: a wireless voice communication device coupled to a first

wireless network; and a wireless data communication device coupled to a second

wireless network; and said data channel connects said server and said wireless data

communication device through the second wireless network [col. 10: lines 47-63].

Regarding claim 13, Schumacher discloses a plurality of workstations in wired

communication with said server, each associated with one or more users in the plurality

of users [col. 10: lines 47-63].

Regarding claim 36, Schumacher discloses a communication system,

comprising: a server; and a plurality of remote and mobile subsystems in

communication with said server, said plurality of subsystems comprising a first

subsystem associated with a first user; and a second subsystem associated with a

second user; wherein said server is operable to provide availability status information

regarding the second user to the first user; accept a command signal from the first

subsystem requesting updated status information regarding the second user; and

provide the updated status information [[fig. 1; col. 5: line 25 – col. 6: line 8; col. 7: lines 15-18; col. 8: lines 8-14; col. 9: lines 38-44; col. 10: lines 39-44, 55-59].

Regarding claim 37, Schumacher discloses said first subsystem comprises a wireless data communication device, and the status information and updated status information are communicated from said server to said wireless data communication device [col. 10: lines 47-63].

3.   Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by prior art made of record in the first office action, Schuster et al., US Patent Number 6,446,127 (hereinafter Schuster).

Regarding claim 1, Schuster discloses a system comprising: a private communication server maintaining availability information regarding a plurality of users; a plurality of personal communication subsystems, each associated with a user in the plurality of users and each in wireless communication with said server; and a data channel between said server and a first one of said plurality of subsystems, the first one of said subsystems being associated with a first user; wherein said server is configured to communicate at least a portion of the availability information through said data channel to at least a first subsystem, and to respond to command signals carried from the first subsystem to said server by said data channel [figs. 1-4; col. 4: lines 23-37].

Double Patenting

4.   A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or

discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection based upon 35 U.S.C. 101.

5.   Claims 1-13, 36 and 37 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13, 36, and 37 of copending Application No. 11/028,165. This is a <u>provisional</u> double patenting rejection since the conflicting claims have not in fact been patented.

Response to Arguments

6.   Applicant's arguments filed 7/10/06 have been fully considered but they are not persuasive. Applicant argues that Schumacher does not teach communicating availability information over a data channel. However, the Examiner respectfully disagrees as Schumacher teaches alerting the user to the presence of a call through the data channel as admitted in Applicant's arguments (page 12). As broadly interpreted, this reads on availability information. Further, Schumacher teaches alerting the user through wireless message data networks [col. 10: lines 39-59] and using a data channel to provide screening information [col. 13: lines 25-28]. Schumacher also teaches that the data channel can be two-way. Therefore, the user can send commands via the data channel.

Applicant argues that it is not inherent to update the availability information at

predetermined intervals to detect a change in availability. The Examiner contends that

this feature is inherent and also directs Applicant to col. 8, lines 8-14 for further support.

Applicant argues that it is not inherent to utilize a log-in procedure. The

Examiner contends that log-in procedures are inherent (or at least obvious), especially

in the workgroup environment disclosed in Schumacher wherein there a number of

different users using a number of office equipment.

The Examiner contends that the remaining dependent claims are met by the

reference citations above.

Applicant argues that Schuster does not teach communicating availability

information through a data channel. However, the Examiner respectfully disagrees as

Schuster explicitly teaches communicating information over the data network [col. 4:

lines 23-37].

Conclusion

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erika A. Gary whose telephone number is 571-272-7841. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 571-272-7905. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ERIKA A. GARY
PRIMARY EXAMINER

EAG
September 25, 2006